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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,091	08/09/2001	Ann Killary	UTSC:651US	4158

7590 05/12/2004

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EXAMINER

WHITEMAN, BRIAN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/927,091

**Applicant(s)**

KILLARY ET AL.

**Examiner**

Brian Whiteman

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/26/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 17-97 is/are pending in the application.
- 4a) Of the above claim(s) 18-23, 34-43 and 45-96 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 24-33, 44, 97 is/are allowed.
- 6) ☒ Claim(s) 7 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Final Rejection**

Claims 1-7 and 17-97 are pending.

Applicants' traversal, the amendment to claims 7, 24, and 97, the cancellation of claims 8-16 and 98-100 filed on 3/26/04 is acknowledged and considered.

The status of claim 96 (original) in the amendment filed on 3/26/04 is incorrect. The status of the claim 96 is (withdrawn). Suggest correcting the status of claim 96. When filing the amendment to this instant action, applicants are reminded to follow the revised amendment practice 37 CFR 1.121. See 68 Fed. Reg. 38611 (June 30, 2003) or website <http://www.uspto.gov/web/patents/ifw/>.

### ***Election/Restrictions***

Claims 18-23, 34-43, and 45-96 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed on 9/22/03.

### ***Information Disclosure Statement***

The IDS filed on 10/7/02 indicates that there are 3 pages. The examiner only signed page 1 of the IDS filed on 10/7/02 because pages 2 and 3 were not available for the examiner to sign. If the applicants want the patents and/or articles on pages 2 and 3 from the IDS to be considered

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and/or initialed by the examiner, then the applicants should submit pages 2 and 3 of the IDS in response to the instant office action.

### ***Drawings***

The drawings were received on 8/9/01. These drawings are acceptable.

### ***Claim Objections***

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Feder et al., (US 5,872,237). Feder teaches an isolated nucleotide sequence that has 15 contiguous base pairs with applicant's SEQ ID NO: 3 and the nucleotide sequence has 3416 base pairs.

Applicant's arguments filed 3/26/04 have been fully considered but they are not persuasive. Applicants argue that by amending claim 7 with the limitation of cancelled claim 16, the prior art rejection in the previous office action does not anticipate the claimed invention.

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Applicants' argument is moot because of the new rejection and applicants did not amend claim 7 with the limitation of claim 16. Cancelled claim 16 recited "about 2500 contiguous base pairs of SEQ ID NO: 3." Claim 7 recites "An isolated and purified nucleic acid of about 2500 to about 5000 base pairs comprising about 15 contiguous base pairs of SEQ ID NO: 3."

### ***Response to Arguments***

Applicant's arguments, filed 3/26/04, with respect to the claim objections have been fully considered and are persuasive. The objection of claims 1-6 and 97 has been withdrawn because of the amendment to claim 1 and claim 97.

Applicant's arguments, filed 3/26/04, with respect to the 101 rejection have been fully considered and are persuasive. The rejection of claims 7-17 has been withdrawn because of the amendment to claim 7 and the cancellation of claims 8-16.

Applicant's arguments, filed 3/26/04, with respect to the 112 first paragraph rejections have been fully considered and are persuasive. The rejection of claims 1-6 and 97 has been withdrawn.

Applicant's arguments, filed 3/26/04, with respect to the 102(e) as being anticipated by Waterson have been fully considered and are persuasive. The rejection of claims 7-15 and 97-100 has been withdrawn because of the amendment to claim 7 and 97 and the cancellation of claims 98-100. Waterson does not teach an isolated nucleic acid of about 2500 to about 5000 base pairs.

Applicant's arguments, filed 3/26/04, with respect to the 102(e) as being anticipated by Wang have been fully considered and are persuasive. The rejection of claims 7-14 and 97-100

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has been withdrawn because of the amendment to claim 7 and 97 and the cancellation of claims 98-100. Wang does not teach an isolated nucleic acid of about 2500 to about 5000 base pairs.

Applicant's arguments, filed 3/26/04, with respect to the 102(e) as being anticipated by Penn et al., have been fully considered and are persuasive. The rejection of claims 7-13 and 97-100 has been withdrawn because of the amendment to claim 7 and 97 and the cancellation of claims 98-100. Penn does not teach an isolated nucleic acid of about 2500 to about 5000 base pairs.

### ***Conclusion***

Claims 1-6, 24-33, 44, and 97 are in condition for allowance because the claims are free of the prior art of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

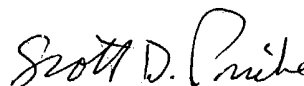
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (571) 272-0764. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00 (Eastern Standard Time), with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, SPE - Art Unit 1635, can be reached at (571) 272-0760.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Brian Whiteman  
Patent Examiner, Group 1635



SCOTT D. PRIEBE, PH.D  
PRIMARY EXAMINER